



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/092,369

03/06/2002

Samantha H. Stetson

12000097-0004-002

8236

26263

7590

02/12/2010

SONNENSCHN NATH & ROSENTHAL LLP

P.O. BOX 061080

WACKER DRIVE STATION, WILLIS TOWER

CHICAGO, IL 60606-1080

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

02/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/092,369	Applicant(s) STETSON ET AL.	
	Examiner Raquel Alvarez	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,11-14,16-19,21,22,24-26,31,33,35,37,45,46,48-51,54-56,58,60,72,74 and 78-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,8,11-14,16-19,21,22,24-26,31,33,35,37,45,46,48-51,54-56,58,60,72,74 and 78-82.

DETAILED ACTION

1. This office action is in response to communication filed on 10/23/2009.
2. Claims 1, 8, 11-14, 16-19, 21-22, 24-26, 31, 33, 35, 37, 45-46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are presented for examination.

Claim Rejections - 35 USC § 112

3. Claims 1, 31, 45, 54, 56, 58, 72 and 74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification calls for an advertisement but it doesn't describe "the advertisement is still displayed to the user". The examiner is interpreting this limitation as the advertisement being an inactive, non motion ad.

Correction is required.

4. Claims 1, 31, 45, 54, 56, 58, 72 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The negative limitation of "said World Wide Web page is not an advertisement" points out to what is excluded in the claim rather than what is included. For purpose of examination, the claims will be interpreted according to the specification which discloses on paragraphs 0006, 0011,

Art Unit: 3688

0014 the web page containing and displaying the advertisement that will be presented to the users.

Correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 8, 11-14, 16-19, 21-22, 24-26, 31, 33, 35, 37, 45-46, 49-51, 54-56, 58, 60, 72, 74 and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (6,128,663 hereinafter Thomas) in view of Official Notice.

With respect to claims 1, 8, 11-14, 16, 18-19, 31, 33, 35, 45, 49-50, 54-56, 58, 60, 72, 74, 78-81 Thomas teaches displaying a message in conjunction with an advertisement on a World Wide Web Page (Abstract). Determining an advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page is not an advertisement (i.e. content of the output requested)(col. 4, lines 53-65); determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said advertisement (i.e. banner ad)(col. 4, lines 53-65 and col. 8, lines 64-66); determining targeting criteria associated with said message (i.e. banner ad related to the requested page); receiving a request to serve said World Wide Web page

Art Unit: 3688

and serving said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53 to col. 9, lines 1-9); serving said advertisement for display on said World Wide Web page such that at least a portion of the content included in said World Wide Web page is still displayed to the user, tailoring said message based on said targeting criteria and serving said tailored message for display on said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53-65).

With respect to receiving personal information from a user about the user. Thomas teaches receiving personal information about the user (col. 2, lines 1-24). Thomas is silent as to the information being received from the user. Official Notice is taken that it is old and well known to receive personal information from the user such as user's name, age and gender when a user fills out an application and the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving personal information from the user in order to allow the user control of his or her information.

With respect to said tailored message being separate from the advertisement. Thomas teaches the user receiving a banner advertisement (tailored message) the banner advertisement (tailored message) being separate from the requested page (advertisement). Thomas is silent as to the location of the message in proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

With respect to claims 21-22, Thomas further teaches tailoring said message based on external information (i.e. receiving demographic information from other sites)(col. 2, lines 64 to col. 3, lines 1-24).

Claim 17 further recites serving a second message when said tailored message is no longer to be displayed. Official Notice is taken that it is old and well known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included serving a second message when said tailored message is no longer to be displayed in order to allow the customer to always receive or be exposed to a message.

Claims 24-25, 37, 51 further recite that said tailored message is to be displayed proximal to the advertisement. Thomas is silent as to the location of the message in proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

Claim 26 further recites changing a display attribute within said tailored message. Official Notice is taken that changing display attribute within a message such as changing display color or image will bring the user's attention to the message.

Claims 46, 82 further recite serving or determining a default message if said targeting criteria has not been met. Official Notice is taken that it is old and well known to serve default messages when said targeting criteria hasn't been met. For example, default messages or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Response to Arguments

Appellant argues that Thomas doesn't teach the greeting being related to the advertisement and that just because selection of an advertising banner to be displayed is based on a demographic profile and selection of a greeting to be displayed is based on a separate demographic profile does not mean that the greeting is related to the advertisement in general. The Examiner disagrees with Appellant because the tailored message being the banner ad of Thomas contains a greeting about the user and information about the requested page. In Thomas, the banner ad is equivalent to the tailored message in the claims and the content of requested page is equivalent to the advertisement being claimed. In addition, Thomas teaches on col. 4, lines 60-65, "particular advertising banner (tailored message) that is chosen to be transmitted with the content of requested page (advertisement) is determined not, randomly, but in

Art Unit: 3688

accordance with the **demographic identifier**....selecting appropriate **variant of the requested page**” As can be seen by the cited portion of Thomas above, Thomas teaches the greeting message (banner) being based on demographic identifier and appropriate **variant** of the requested page so therefore the tailored message or banner are not chosen randomly but customized based on the **demographic and user interests** (col. 4, lines 1-14) **and variant of the requested page** (advertisement)(col. 4, lines 60-65). For example, in the case of Thomas the user request some content, for example the user searches for” weekend activities” and based on the user’s demographic (interest, income etc) the greeting (banner) displayed to the user will be based on the user’s demographic and the variant of the requested page (advertisement). Using the example above the user will receive a greeting (banner) like a customized weekend activity tailored to computers users. The greetings (banner) received by the users will be different based on the variant of the requested page (advertisements) and their demographics.

Applicant argues that the banner ad/ greeting of Thomas bear no resemblance to the requested page/advertisement of the present claims. First of all, the Examiner wants to point out that according to Applicant’s written description, the advertisements is part of the content on a web page, and Thomas teaches the requested page being based on the user’s search and displayed in the content of a web page (see Figure 2A), the greeting (banner) displayed by the advertisement (content of the page) being related to the user’s demographics and the advertisements (content of the page).

Art Unit: 3688

With respect to the Official Notices taken pertaining to the following well known facts: 1) That it is old and well-known to receive personal information from a user such as a user's name, age and gender when a user fills out an application and the like; 2) That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user's attention to the ad; 3) That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed; 4) That changing display attribute within a message such as changing display color or image will bring the user's attention to the message and customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public. The Examiner has provided examples and motivation of the well known facts and Appellant hasn't provided a proper challenge that would at least cast reasonable doubt that the known facts weren't known prior to Applicant's invention of June 3, 2002. "to adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.11 I(b)." MPEP § 2144.03 (C). An adequate traverse must contain adequate information or argument to create on its face, a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. See *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). Since, Applicant hasn't provided such a challenge, the Official Notices are maintained.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
2/3/2010